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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/368,792	08/05/1999	SANDRA L. STANDIFORD	10981001-1	5929
22879	7590	02/25/2005	EXAMINER	
HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400			TRAN, THAI Q	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/368,792

Applicant(s)

STANDIFORD ET AL.

Examiner

Thai Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 August 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

1. Please include the new Art Unit 2616 in the caption or heading of any written or facsimile communication submitted after this Office Action because the Examiner, who was assigned to Art Unit 2615, will be assigned to new Art Unit 2616. Your cooperation in this matter will assist in the timely processing of the submission and is appreciated by the Office.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Objections***

3. Claims 7-8 are objected to because of the following informalities:

Regarding claim 7, line 2, "the a key frame marker" should be changed to –the key frame marker--; and

Regarding claim 8, line 2, "the a key frame marker" should be changed to –the key frame marker. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1 and 3-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lemelson (US 5,446,599).

Regarding claim 1, Lemelson discloses an apparatus for recording video signal (Figs. 1 and 5), the apparatus comprising:

an analog video cassette player (24 of Fig. 1, col. 3, lines 22-42 and col. 7, lines 10-18) for producing analog video output;

an analog to digital converter for converting said analog video output into digital data (an analog-to-digital converter 71 of Fig. 5, col. 7, lines 10-18),

at least one recorder (a solid state memory 133 of Fig. 5, col. 12, lines 25-38) employing storage medium for storing the video data, wherein said cassette player, said converter and said storage medium are disposed within a single container wherein said storage medium is inserted into and removable from said container; and

a key frame marker (the bank of code generating switches 95 of Fig. 5, col. 11, lines 9-42 and col. 12, lines 55-61) for inserting at least one marker into the digital data. However, Lemelson does not specifically disclose that the storage medium is a digital storage medium.

Lemelson also teaches in col. 12, lines 10-23 that "it may be possible to eliminate the analog-to-digital and the digital-to-analog devices employed in the circuit diagram so as to simplify the electronic circuitry presented and described" and "It is noted that the memory 70, which is provided herein as a RAM or read-write memory may also comprise any suitable type of memory such as a serial shift register, a charge coupled (CCD) device, a magnetic bubble memory, a rotating disc or drum or any other type of pulse signal storage device capable of storing at least a million bits of full color, high resolution, single frame picture information wherein the appropriate circuit modifications to operate such memory would be provided".

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known digital storage medium as taught by Lemelson into Lemelson's system since it merely amounts to selecting an alternative equivalent storage medium or increase the quality of the video signal to be recorded/reproduced because digital recorder has higher quality than analog recorder.

Regarding claim 3, Lemelson discloses all the claimed limitations as discussed in claim 1 above except for providing that the video cassette player employs a VHS format.

It is noted that VHS cassette tape is old and well known in the art and; therefore, Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well-known VHS cassette tape into Lemelson system since it merely amounts to selecting an alternative equivalent recording medium.

Regarding claim 4, Lemelson discloses all the claimed limitations as discussed in claim 1 above except for providing that the digital storage medium is one of a CD R or a CD RW.

It is noted that CD R and CD RW are old and well known in the art and; therefore, Official Notice is again taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well-known CD R or CD RW into Lemelson system since it merely amounts to selecting an alternative equivalent recording medium.

Regarding claim 5, Lemelson discloses all the claimed limitations as discussed in claim 1 above except for providing that the digital storage medium is a recordable DVD.

It is noted that recordable DVD is old and well known in the art and; therefore, Official Notice is again taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well-known recordable DVD into Lemelson system since it merely amounts to selecting an alternative equivalent recording medium.

Regarding claim 6, Lemelson discloses the claimed wherein the storage medium is selectable by the user (col. 12, lines 25-38).

Regarding claim 7, Lemelson also discloses the claimed wherein the a key frame marker for marking marks abrupt changes in video image sequences, thereby enabling a user to readily locate a beginning and an end of a particular video sequence (the codes switches 95 of Fig. 5, col. 11, lines 9-42 and col. 12, lines 55-61).

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Regarding claim 8, Lemelson further discloses the claimed wherein the a key frame marker for marking marks positions in a sequence of said digital data at selectable time intervals (the codes switches 95 of Fig. 5, col. 11, lines 9-42 and col. 12, lines 55-61).

Regarding claim 9, Lemelson discloses all the claimed limitations as discussed in claim 1 above except for providing that the video cassette player employs the 8 mm format.

It is noted that 8 mm video cassette is also old and well known in the art and; therefore, Official Notice is again taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well-known 8 mm video cassette into Lemelson system since it merely amounts to selecting an alternative equivalent recording medium.

Method claim 10 is rejected for the same reasons as discussed in apparatus claim 1 above.

Regarding claim 11, Lemelson also discloses the claimed determining a required digital storage format prior to said step of converting based upon detection of a format of said inserted storage medium (a solid state memory 133 of Fig. 5, col. 12, lines 25-38).

Method claim 12 is rejected for the same reasons as discussed in apparatus claim 7 above.

Regarding claim 13, Lemelson discloses the claimed inserting at least one marker in said digital video data at selectable time intervals, thereby enabling a user to

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readily identify particular video sequences during playing of said digital video data (the codes switches 95 of Fig. 5, col. 11, lines 9-42 and col. 12, lines 55-61).

Method claim 14 is rejected for the same reasons as discussed in apparatus claim 4 above.

Method claim 15 is rejected for the same reasons as discussed in apparatus claim 5 above.

Regarding claim 16, Lemelson discloses all the claimed limitations as discussed in claims 1 and 10 above except for providing that the digital storage medium is digital tape.

It is noted that digital video tape recorder is also old and well known in the art and; therefore, Official Notice is again taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well-known digital video tape recorder into Lemelson system since it merely amounts to selecting an alternative equivalent recording medium.

Method claim 17 is rejected for the same reasons as discussed in apparatus claim 3 above.

Method claim 18 is rejected for the same reasons as discussed in apparatus claim 9 above.

Claim 19 is rejected for the same reasons as discussed in claims 1 and 4-5 above.

Claim 20 is rejected for the same reasons as discussed in claim 7 above.

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Regarding claim 21, Lemelson discloses the claimed removing the storage medium from said container after storing said video data in said storage medium (a solid state memory 133 of Fig. 5, col. 12, lines 25-38).

Regarding claim 22, Lemelson also discloses the claimed wherein the digital storage medium is insertable into and removable from said single container (a solid state memory 133 of Fig. 5, col. 12, lines 25-38).

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lemelson (US 5,446,599) in view of Mincy et al (US 6,052,508).

Lemelson discloses all the claimed limitations as discussed in claim 1 above except for providing the claimed a video port for receiving analog video information from an external source.

Mincy et al teaches a moving picture recording device (col. 4, lines 35-41) having an "EXT" key for selecting external video as the source for either program output, monitor output or recording or insertion as an event (col. 17, lines 64-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the "EXT" key as taught by Mincy et al into Lemelson's system in order to increase the flexibility of the system of Lemelson by allowing the external video signal to be viewed or recorded or inserted as an event.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

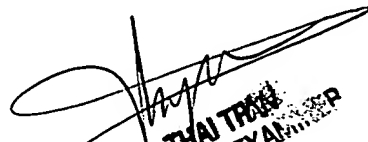
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (703) 305-4725. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTQ



THAI TRAN  
PRIMARY EXAMINER